

REMARKS

The applicant has carefully considered the official action dated July 13, 2004, and the references it cites. The official action rejects claims 1-22 under 35 U.S.C. § 103(a) as unpatentable over Beelitz et al. in view of one or more of Ross and Soehnlén et al. The applicant respectfully traverses the rejections. Accordingly, claims 1-22 are pending and at issue in this application. In view of the following remarks, the applicant respectfully requests reconsideration of this application.

The applicant respectfully submits that independent claim 1 is allowable over the art of record. In particular, none of the references discloses or suggests receiving an order from a website server as recited in independent claim 1.

Beelitz et al. fail to disclose receiving an order from a website server. On the contrary, Beelitz et al. teach that orders are received from a user terminal, which may execute an Internet browser application to communicate with a control computer via, for example, the Internet. The user terminal from which orders are received is not a website server as recited in claim 1. Even if the control computer disclosed by Beelitz et al. were configured to be a website server, a point which the applicant does not concede, the control computer is merely configured to process orders received from the user terminal which, as noted above, is not a website server. The official action refers to column 3, lines 32-42 of Beelitz et al. to support the contention that Beelitz et al. disclose receiving orders from a website server. However, the applicant respectfully submits that the offered support only generally indicates that a computer system vendor can implement a build-to-order computer system over a network and fails to provide any evidence of a system that receives orders from a website server, as recited in claim 1.

The references Soehnlen et al. and Ross also fail to disclose receiving an order from a website server as recited in claim 1. Accordingly, claim 1 and claims 2-8 dependent thereon are in condition for allowance.

Further, even if Beelitz et al. disclosed receiving an order from a website server as recited in claim 1, a point which is not conceded, it would not have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Beelitz and Soehnlen et al. as contended in the official action. In particular, Beelitz et al. disclose a system for specifying, ordering, and manufacturing a built-to-order computer system. The system disclosed by Beelitz et al. enables a purchaser to communicate their order to buy a computer system to a central control system via a communication network. The central control system guides and facilitates the purchaser during the selection of software and hardware components so that the purchaser is only presented component choices that are compatible with prior component selections (i.e., component selections made at an earlier time in the purchase process). The control system then causes the computer system specified by a purchaser to be manufactured in accordance with the compatible component selections. As a result, the system taught by Beelitz et al. ensures that a built-to-order computer system having known compatible hardware and software components will be manufactured and delivered to the purchaser.

Soehnlen et al., on the other hand, discloses an ice cream manufacturing and packaging process. The system disclosed by Soehnlen et al. is configured to apply different retailer labels to ice cream containers to enable a single production line to efficiently produce ice cream for each of the different retailers.

The applicant respectfully submits that the business relationships on which the system disclosed by Soehnlen et al. are based are fundamentally different from the business

relationships on which the system disclosed by Beelitz et al. are based. Thus, the systems disclosed by Beelitz et al. and Soehnlén et al. are adapted to accomplish different objectives. Specifically, Soehnlén et al. teach that a single manufacturer may be responsible for manufacturing several brands of ice cream for as many retailers. It is common knowledge that such business relationships are acceptable in the case of ice cream manufacture and sale because purchasers of ice cream do not expect that retailer or store branded ice cream is actually manufactured by that store or retailer. Moreover, retailers are by nature in the business of selling goods manufactured by other entities and do not typically manufacture anything.

In contrast, the system disclosed by Beelitz et al. is specifically adapted for use by computer system manufacturers which, as is commonly known, are in the business of assembling computer systems and compete with one another on the basis of (i.e., derive competitive advantage from) the quality, cost, and timeliness of their assembly process. In addition, the system taught by Beelitz et al. is based on a computer system manufacturer's detailed knowledge of a variety of complex computer component interactions associated with its computer system.

The examiner's proposed modification of the system disclosed by Beelitz et al. based on the teachings of Soehnlén et al. would effectively result in the establishment of another type of business entity that manufactures and private labels computer systems for multiple on-line computer system vendors. Neither Beelitz et al. nor Soehnlén et al. even remotely hint that such a significant modification of the system disclosed by Beelitz et al. would be viable or advantageous. Further one of ordinary skill in the art of computer system manufacturing would not view the private labeling business relationships on which the

system disclosed by Soehnlén is based to be applicable or advantageous to the highly complex build-to-order computer ordering system disclosed by Beelitz et al. On the contrary, because it is commonly understood that computer system manufacturers compete on the basis of assembly quality, cost, and timeliness of their products, such manufacturers would want to be the only manufacturer to offer a build-to-order system, or at least would want to offer a better build-to-order system than their competitors. Thus, the examiner's proposed modification of Beelitz et al. would totally eliminate any competitive advantage afforded by the build-to-order system between all computer system vendors sharing the build-to-order system.

Still further, the examiner's proposed modification of the system disclosed by Beelitz et al. appears to be based on an impermissible use of hindsight. On page 3 of the most recent official action, the examiner states "It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Soehnlén et al. with the invention of Beelitz et al. to employ different source identifiers depending on the source of the order to meet customer need." The applicant respectfully submits that the examiner's asserted motivation is instead merely a result of a proposed combination. The examiner has failed to provide any basis or evidence for a "customer need" that would motivate one of skill in the art to significantly change the business relationships on which the system disclosed by Beelitz et al. is based. The only apparent customer need to which the system disclosed by Beelitz et al. is directed is to provide a build-to-order interface that facilitates ordering and ensures delivery of a computer system containing compatible components. Nowhere do Beelitz et al. hint that there is customer need to establish a business entity that manufactures and private labels computer systems for multiple on-line computer system vendors. Nor is such a significant change in the business relationships between customers and computer

system vendors consistent with a computer system vendor's basis for competitive advantage as set forth above.

Accordingly, the applicant respectfully submits that independent claim 1 and claims 2-8 dependent thereon are in condition for allowance.

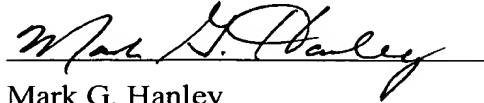
The applicant respectfully submits that independent claim 9 is also allowable over the art of record. In particular, none of the references discloses or suggests a method of fulfilling book orders that use a book order fulfillment server to receive a book identifier, a destination address, and payment information via a wide area network. While Ross discloses a system for reproducing a copy of a single book, the system taught by Ross is particularly adapted for direct consumer sales (i.e., point of purchase sales). In fact, Ross teaches away from a method such as that recited in claim 9. More specifically, Ross teaches that systems in which books are ordered and then shipped later are undesirable (see col. 1, lines 39-43). Thus, one of ordinary skill in the art would not be motivated to apply the teachings of Ross to modify the system taught by Beelitz et al. to perform the method recited in claim 9. Accordingly, the applicant respectfully submits that independent claim 9 and claims 10-13 dependent thereon are in condition for allowance.

The applicant respectfully submits that claims 14-22 are also allowable over the art of record for at least the reasons set forth above in connection with claim 9.

In view of the foregoing, the applicant respectfully submits that this application is now in condition for allowance. If there are any remaining matters that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

PATENT
Attorney Docket No.: 20008/G057A

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Mark G. Hanley", is written over a horizontal line.

Mark G. Hanley
Reg. No. 44,736
Attorney for Applicant
Grossman & Flight, LLC
20 North Wacker Drive
Suite 4220
Chicago, Illinois 60606
312.580.1020

Dated: 9.15.04